



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,999	10/25/2005	Junya Fujii	024918-0122	5954

22428 7590 01/09/2007
FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

SANDY, ROBERT JOHN

ART UNIT	PAPER NUMBER
----------	--------------

3677

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/531,999	FUJII ET AL.	
	Examiner	Art Unit	
	Robert J. Sandy	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed on 20 April 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

The claims are objected to because they include text enclosed within parentheses, which is improper.

Specification

The abstract of the disclosure is objected to because the abstract exceeds more than 150 words, and exceeds more than one paragraph. The abstract of the disclosure is further objected to because the abstract contains legal terms or phrase considered as improper format in a abstract. Such terms and phrases as "The present invention..", "comprises", "means", and "wherein" must be deleted from the instant abstract. Applicant should review entire abstract and correct such occurrences. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as to the following:

In claim 1, bridging lines 3 and 4, recitation of "the opposed clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

In claim 1, line 5, there is no antecedent basis for "the latching".

In claim 1, line 7, recitation of "the clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

In claim 1, lines 8 though 9, the claimed subject matter represented by recitation of "added to the latching means by the latching releasing means, to the direction to release the latching of the latching part" is not understood what structure of the claimed device the subject matter is associated or in reference to, thereby rendering the claims indefinite.

In claim 2, line 2, recitation of "the clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

In claim 3, line 2, there is no antecedent basis for "the latching releasing means side".

In claim 4, line 3, recitation of "the clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

In claim 4, bridging lines 6 and 7, there is no antecedent basis for "the other tip end".

In claim 4, line 7, recitation of "the clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

In claim 6, line 2, recitation of "the clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

In claim 10, line 2, recitation of "the opposed clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

In claim 11, line 2, recitation of "the clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

In claim 11, recitation of "the latching means is formed is bound..." and

In claim 12, line 2, recitation of "the clipping arm" renders the claims indefinite for not distinguishing between the "opposed clipping arms" established in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japan document No 2002-321746, filed 25 April 2001, and published 05 November 2002.

Claims 1-11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson et al. (U.S. Patent No. 5,050,272). Robinson et al. ('272) discloses a clip (11) comprising opposed clipping arms (sheath 13 and blade 47) capable of forming an independent, separate space by pressing and holding there between a clipped object constituted of a flexible hollow member (e.g., ice bag 75), and a latching means (locking member 67 and locking shoulder 35), disposed on one end of the each of the opposed clipping arms, which has a latching part (locking member 67 and locking shoulder 35) capable of latching the clipping arms which are pressing and holding the clipped object there between, wherein the clip has a latching releasing means (tip end 71) capable of releasing the latching by an external latching releasing force headed to an external direction from the clipping arm, and a structure (structural portion of member 67 having the cam surface 74) of the latching means has a supporting point part (69) acting the latching releasing force, added to the latching means by the latching releasing means, to the direction to release the latching of the latching part;

Art Unit: 3677

(concerning claim 2, so far as definite) the latching means is disposed at the both ends of the clipping arm;

(concerning claim 3) the latching part of the latching means is disposed at the latching releasing means side of the supporting point part;

(concerning claim 4) the latching means is constituted of the latching part having a male member (structure defining locking member 67) and a female member (structure defining slot), and of an elastic piece (71) formed on one tip end of the clipping arm and capable of oscillating with the use of the supporting point part (69) as a fulcrum by the latching releasing means; one of the male member (67) and the female member is formed on a tip end of the elastic piece; and the other of the male member and the female member is formed on the other tip end of the clipping arm;

(concerning claim 5) the latching releasing means and the latching means are integrally molded;

(concerning claim 6, so far as definite) the latching releasing means, the latching means and the clipping arm are integrally molded;

(concerning claim 7) the latching releasing means is a band shape elastic piece (portion between 69 and 73) whose tip end is bound to the elastic piece of the latching means;

(concerning claim 8) the latching releasing means is comprised of a pull-tab (end portion 71) integrally molded with the band shape elastic piece bound to the elastic piece of the latching means;

(concerning claim 9) . The clip according to claim 1, wherein the latching releasing means is comprised of a thread-like article (i.e., section having portion between 69 and 73);

(concerning claim 10, so far as definite) a structure wherein the other end of the opposed clipping arm on which the latching means is formed is bound by an axis (pin 27) in an oscillating way; and

(concerning claim 11) a structure wherein the clipping arm on which the latching means is formed is bound by a hinge (27) integrally molded with the clipping arm and formed on the other end, opposite the side where the latching means is formed, in an oscillating way.

Art Unit: 3677

Claim Rejections - 35 USC § 103

Claim 12, so far as definite, is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. ('272) in view of Oh et al. (U.S. Patent No. 4, 834,096). Robinson et al. ('272) discloses the claimed clip except for wherein at least the clipping arm is comprised of a resin made by mixing a glass fiber into a polyoxymethylene resin. However, Oh et al. ('096) discloses a clip made from "polyoxymethylene" (col. 9, line 26). Therefore, it would have been obvious to one of ordinary skill in the art to have manufactured the clip of Robinson et al. ('272) from a polyoxymethylene resin, as suggested by Oh et al. ('096), since Oh et al. ('096) recognizes that polyoxymethylene is a preferable suitable plastic material among "many relatively strong engineering plastics" when molding clip portions of "a single integral piece of molded plastic." (col. 9, lines 20-23).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Sandy whose telephone number is 571-272-7073. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert J. Sandy
Primary Examiner
Art Unit 3677

ROBERT J. SANDY
PRIMARY EXAMINER